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THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

MAILED UNITED STATES PATENT AND TRADEMARK OFFICE

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PAT & TM OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT S. SCHWARTZ, RONALD G. TUCH
and RODNEY G. WOLFF

Appeal No. 95-4893
Application 08/040,045¹

ON BRIEF

Before CALVERT, LYDDANE and FRANKFORT, Administrative Patent Judges.

LYDDANE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1 through 13. Claims 14 through 28, which

¹ Application for patent filed March 30, 1993.

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are the only other claims pending in the application, stand withdrawn from further consideration by the examiner pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.

The subject matter on appeal is directed to an indwelling intravascular device and to a vascular prosthesis. Claims 1 and 7 are exemplary of the invention and a copy thereof, as they appear in the appendix to the appellants' brief, is reproduced as follows:²

1. An indwelling intravascular device for implantation in a blood vessel of a patient over an extended period of time, said intravascular device having at least one tissue-contacting surface, the tissue-contacting surface subject to contact with a wall of the blood vessel, the tissue-contacting surface comprising a base material and a thin layer of a metal from Group VA of the Periodic Table adherent to the base material.

²We note that appellants have disclosed that the "tissue-compatible metal employed is preferably a metal from Group VA of the Periodic table of the elements. This group includes vanadium, niobium and tantalum" (page 9, lines 32-34 of appellants' specification). However, vanadium, niobium and tantalum appear in Group VB of the Periodic table of elements as apparent from observing a copy of the Periodic table. Note also the definition for "tantalum" on page 993 of the copy of The Condensed Chemical Dictionary supplied by appellants as an attachment to the Brief which states that tantalum is "in group VB of the periodic system." Consequently, we understand these claims to mean that the "thin layer of a metal" recited therein is to be from Group VB of the Periodic Table. Accordingly, appellants should amend the specification and claims 1, 7 and 12 to reflect this interpretation in order to avoid a rejection of the claims under 35 USC 112, second paragraph.

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7. A vascular prosthesis for implantation in a blood vessel of a patient over an extended period of time, said vascular prosthesis having at least one tissue-contacting surface subject to contact with a wall of the blood vessel and one blood-contacting surface, the tissue-contacting surface comprising a base material and a thin layer of a metal from Group VA of the Periodic Table adherent to the base material.

The references of record relied upon by the examiner in rejections of the claims under 35 USC 102(b), under 35 USC 102(e) and under 35 USC 103 are:

Urquhart	3,797,485	Mar. 19, 1974
von Recum et al. (von Recum)	4,871,366	Oct. 3, 1989
Evans et al. (Evans)	5,226,909	July 13, 1993
		(Filed Nov. 4, 1992)

Claims 1 through 3, 5 through 9 and 11 through 13 stand rejected under 35 USC 102(b) as being clearly anticipated by Urquhart.

Claims 1 through 3, 5 through 9, 11 and 12 stand rejected under 35 USC 102(e) as being clearly anticipated by Evans.

Claims 4 and 10 stand rejected under 35 USC 103 as being unpatentable over either Urquhart or Evans in view of von Recum.

Rather than reiterate the examiner's statement of the above rejections and the conflicting viewpoints advanced by the

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examiner and the appellants, we refer to pages 3 through 8 of the examiner's answer, to pages 9 through 55 of the appellants' brief and to the appellants' reply brief for the full exposition thereof.

OPINION

In arriving at our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art, and to the respective positions advanced by the appellants and by the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the examiner's rejections under 35 USC 102(b), under 35 USC 102(e) and under 35 USC 103 with respect to all claims on appeal are improper and cannot be sustained. Our reasoning for this determination follows.

With respect to the rejections under 35 USC 102(b) and under 35 USC 102(e), we initially observe that an anticipation under §102 is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. See RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984), cert. dismissed sub nom., Hazeltine Corp. v.

RCA Corp., 468 U.S. 1228 (1984). Additionally, the law of anticipation does not require that the reference teaches what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983) cert. denied, 465 U.S. 1026 (1984) (and overruled in part on another issue) 775 F.2d 1107, 227 USPQ 577 (Fed. Cir. 1985).

Central to the determination of the propriety of the rejections under § 102(b) and § 102(e) is the examiner's conclusion that the preamble of claim 1, "[a]n indwelling intravascular device for implantation in a blood vessel of a patient over an extended period of time," and the preamble of Claim 7, "[a] vascular prosthesis for implantation in a blood vessel of a patient over an extended period of time," are not relevant in reaching a determination under 35 USC 102. Thus, we must initially determine whether the preambles in claims 1 and 7 are to be treated as claim limitations to be accorded patentable weight. In this regard, our reviewing court has stated that preamble language may constitute a claim limitation when it gives "life and meaning" to the claim. See Corning Glass Works v.

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Sumitomo Electric U.S.A. Inc., 868 F.2d 1251, 9 USPQ2d 1962 (Fed. Cir. 1989). In other words, when preamble language is part of the definition of the invention, it provides a limitation. See Diversitech Corp. v. Century Steps Inc., 850 F.2d 675, 7 USPQ2d 1315 (Fed. Cir. 1988).

On the other hand, when the preamble merely states a purpose or intended use for the invention, it is not limiting and instead merely indicates the environment in which the claimed invention operates. See Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 228 USPQ 90 (Fed. Cir. 1985). More particularly, it has been held that a preamble will be denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. See In re Szajna, 422 F.2d 443, 164 USPQ 632 (CCPA 1970).

It is apparent to us, based on a review of the complete specification and claims of appellants' application, that the preambles of appealed claims 1 and 7 are part of the definition of the invention and thus constitute limitations in those claims that give "life and meaning" thereto. Clearly, appellants

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disclose and claim both an "indwelling intravascular device" and a "vascular prosthesis" that are "for implantation in a blood vessel of a patient over an extended period of time." Thus, the invention is limited to those types of devices that are intended "for implantation in a blood vessel of a patient over an extended period of time" (emphasis added).

Accordingly, for a reference to anticipate either claim 1 or claim 7, it must disclose an "indwelling intravascular device" (claim 1) or a "vascular prosthesis" (claim 7) "for implantation in a blood vessel of a patient over an extended period of time." As noted by the appellants, the patent to Urquhart discloses a device intended to administer drugs to the bloodstream by attachment to the exterior of an intact blood vessel and thus is extravascular rather than intravascular, and the patent to Evans discloses an atherectomy catheter that utilizes a cutter blade to remove arterial deposits in a short term intravascular procedure. Therefore, neither of the patents to Urquhart or Evans discloses an "indwelling intravascular device" or a "vascular prosthesis" that are "for implantation in a blood vessel of a patient over an extended period of time" and thus neither can anticipate appealed claims 1 or 7 or the claims

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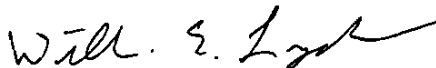
dependent therefrom. Consequently, the rejections of claims 1 through 3, 5 through 9 and 11 through 13 under 35 USC 102(b) as being anticipated by Urquhart and of claims 1 through 3, 5 through 9, 11 and 12 under 35 USC 102(e) as being anticipated by Evans cannot be sustained. Furthermore, the patent to von Recum, as applied by the examiner in the rejection of dependent claims 4 and 10, does not overcome the deficiencies of Urquhart and Evans, and we thus cannot sustain the rejection of these claims under 35 USC 103.

Therefore, the decision of the examiner rejecting claims 1 through 3, 5 through 9 and 11 through 13 under 35 USC 102(b), rejecting claims 1 through 3, 5 through 9, 11 and 12 under 35 USC 102(e), and rejecting claims 4 and 10 under 35 USC 103 is reversed.

REVERSED



IAN A. CALVERT)
Administrative Patent Judge)



WILLIAM E. LYDDANE)
Administrative Patent Judge)



CHARLES E. FRANKFORT)
Administrative Patent Judge)

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